

Remarks

Applicant respectfully submits that entry of this Response is proper as it makes no amendments to the claims.

The Examiner has maintained the rejection of independent claim 1 (and dependent claims 2-10) under 35 U.S.C. 35 U.S.C. §103 as obvious over Hashiguchi, U.S. Patent No. 4,779,613, at the time of the invention. Applicant respectfully requests that the Examiner reconsider this rejection in view of the below Remarks.

Hashiguchi discloses only a hygroscopic material. Hashiguchi does not disclose a moldable matrix material in which the hygroscopic material is imbedded. The Hashiguchi reference is completely missing this element. The Examiner has stated that Hashiguchi "broadly disclose" that the hygroscopic member 192 can be made any size and can be made from many materials, and that "This *broad* disclosure *incorporates* the use of a material where the hygroscopic material is imbedded into a matrix." Applicant respectfully submits that this statement unfairly sweeping and dismissive.

In order for the claimed invention to be obvious over the prior art, there must be some suggestion or motivation in the reference to make the relevant modification. See, e.g., MPEP 2143.01; *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (fact that prior art "may be capable of being modified to run the way the apparatus is claimed, there must be some suggestion or motivation in the reference to do so."). Claim 1 specifically recites a moldable matrix in which the hygroscopic material is imbedded. Hashiguchi does not disclose this element, and a rejection based on the notion that this reference *could* cover a device having this element is improper. There must be some suggestion to make the specific modification. The Examiner has identified none, and the reference includes none.

This is a fundamental distinction from the prior art, including Hashiguchi.

Applicant notes that the cited Hashiguchi reference is the U.S. equivalent of DE 37 08 124, which is specifically discussed in the background of the present application at Paragraph 0006. As explained in that paragraph, the Hashiguchi reference only discloses a hygroscopic substance that requires complete disassembly of the endoscope in order to be replaced. In order to overcome this disadvantage of the device described in Hashiguchi, the present invention provides a hygroscopic substance imbedded in a moldable matrix material. This difference is significant, as it facilitates easy removal and replacement of the hygroscopic material after significant absorption thereby. As explained in Paragraph 0011 of the present application, by imbedding the hygroscopic substance in a freely moldable matrix material, it becomes possible to arrange the hygroscopic substance securely, resistant to moving and abrasion, such that it can be removed and inserted easily and quickly because, since the hygroscopic substance is a component of the structure shaped by the matrix material, there is no need for special installation using additional securing elements. Applicant further notes that, though the Examiner has noted that separation of elements/removability is a design consideration within the skill of the art, Applicant respectfully submits that a novel *structural arrangement* that facilitates removability or replaceability is, of course, patentable. In this case, the present invention does, in fact, employ such a structure—namely, a hygroscopic substance “imbedded in a moldable matrix material... caulked with the hygroscopic substance”—which the prior art does not disclose.

Applicant respectfully notes that, when determining whether prior art anticipates or renders obvious the claimed invention, the relevant question is what the prior art specifically discloses or suggests to one of skill in the art. The fact that a disclosure is “broad” enough that the device disclosed *could* cover a device as claimed is not sufficient unless there is some specific disclosure or suggestion. Applicant respectfully submits that no such suggestion is present in the prior art, and the present application cannot be used to provide this suggestion. *In re Vaeck*, 947 F.2d 488, 493, 20

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U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (suggestion to combine must be found in the prior art, not the applicant's disclosure).

It is respectfully submitted that claims 1-10, all of the claims remaining in the application, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,



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